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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/883,619

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Robert Martin Wynalda JR.

1949-A-CIP

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04/13/2010

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1783

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/883,619	<b>Applicant(s)</b> WYNALDA ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-15, 23, 27, 28, 30-32 and 34-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-15, 23, 27, 28, 30-32 and 34-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **RESPONSE TO AMENDMENT**

1. In view of the appeal brief filed on January 19, 2010, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/David R. Sample/  
Supervisory Patent Examiner, Art Unit 1783

2. Claims 7-15, 23, 27, 28, 30-32 and 34-39 are pending in the application, claims 1-6, 16-22, 24-26, 29 and 33 have been cancelled.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. §103 rejection of claim 7-15, 23, 27, 28, 30-32 and 34-39 over Weisburn et al. (U.S. Patent No. 5,697,498) in view of Eskandry (U.S. Patent No. 6,409,013). made of record in the office action mailed January 21, 2009, pages 2-4, paragraph #4 has been withdrawn due to Applicant's arguments in the Appeal Brief filed January 19, 2010.

***NEW REJECTIONS***

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 103***

5. Claims 7-15, 23, 27, 28, 30-32 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanselmann (U.S. Patent No. 1,186,312) in view of McKowen (U.S. Patent No. 3,244,436) and Widder et al. (2,287,365).

Hanselmann discloses a disk record storage container for holding multiple discs and for providing multiple locations for printed graphics (*title and figures 1 and 3*). The storage container comprises cover having a front cover member (*ref. A*), a rear cover member (*ref. A'*), and a spine (*ref. B*) disposed between the front and rear cover members (*figure 3*) and at least one page having a structure adapted to hold at least one item of recorded media (*envelope, ref. D and page 1, lines 43-68*). The page having first and second side surfaces (*ref. D' and D<sup>2</sup>*); the structure adapted to hold at least one item of recorded media disposed on one of the first and second sides of the page (*page 1, lines 10-16*). The at least one page having at least one edge

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(figure 3). Each page including being formed from two page halves that are connected together in a back to back arrangement so that two discs are accessible from opposite sides of each page (figure 4, inner surfaces of ref.  $D'$  and  $D^2$ ). Each page deemed to be substantially rigid, since each envelope must be capable of holding a phonographic disk record. Furthermore, each page is deemed to be a disc holding hub since they are adapted to hold a disc-shaped item of recorded media. The front and rear cover members being moveable between open and closed positions (figure 3 and page 1, lines 10-16).

Regarding the limitation(s) "recorded media", the Examiner has given the term(s) the broadest reasonable interpretation(s) consistent with the written description in applicant's specification as it would be interpreted by one of ordinary skill in the art. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Donaldson Co., Inc.*, 16 F.3d 1190, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994). Recorder media is any type of media that is capable of being recorded on, such a piece of paper with type or writing on it, a phonographic disk, CD, DVD, plastic films with indicia, etc. Furthermore, the such media's can take different sizes in shape, for example as piece of paper just big enough to have size 5pt font on it all the way to bill boards and the like. Therefore, since Hanselmann's envelopes are large enough to hold a phonographic disk record, they are adapted to hold two items of record media, such as scraps of paper with writing on it. Furthermore, the page is adapted to hold two disc-shaped items, such as CDs or DVDs, since Hanselmann's envelopes are large enough to hold a phonographic disk record which are at least twice a larger as a CD or DVD. This two discs could easily fit therein.

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Hanselmann fails to disclose the edge of the page being connected to the spine with an adhesive to connect the page to the cover and the edge of the page defining a pocket that is V-shaped in cross section to provide a pocket for the adhesive; the V-shaped pocket having an apex disposed directly between the first and second sides of the page.

Hanselmann further discloses that the disk record holder is in the form of a book with a binding (*page 1, lines 43-52 and figure 5*).

Widder discloses phonograph record album that has a plurality of envelopes/pages bond to the spine of the cover like a book with adhesive (*col. 1, lines 5-19 and col. 3, lines 1-22*).

McKowen discloses an improved book binding which is stronger than conventional book binding. (*col. 1, lines 8-10*). The spine has an adhesive/glue to connect the page to the cover and the edge of the page defining a pocket that is V-shaped in cross section to provide a pocket for the adhesive (*figure 1*). The V-shaped pocket having an apex disposed directly between the first and second sides of the page (*figure 1*). Furthermore, the cover is made of paperboard (*col. 2, lines 50-54*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to bind the envelopes/pages of Heselmann with adhesive/glue as taught by McKowen and Widder in order to have a stronger binding. One of ordinary skill in the art would have been motivated to use McKowen page binding configuration because it is stronger than conventional bindings.

Hanselmann further fails to disclose the cover being fabricated from paperboard. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use paper board, as the cover in Hanselmann as taught by McKowen, since the

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selection of a known material based on its suitability for its intended use is prima facie obvious. MPEP 2144.07.

The preamble “CD or DVD storage container” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Furthermore, since Hanselmann discloses that his dick record holder can hold phonographic disks (*page 1, lines 10-16*), each envelop/page is deemed capable of holding at least one CD or DVD, since phonographic disks is substantially larger than a CD or DVD.

Hanselmann further discloses that the page halves are connected together with locking fingers (*ref. D<sup>3</sup>, D<sup>4</sup> and D<sup>5</sup>*). The projecting edges D<sup>3</sup>, D<sup>4</sup> and D<sup>5</sup> are considered to be locking fingers because they are rectangular projecting pieces from each page half that is gummed or contains adhesive that secure the two halves together (*page 1, lines 83-96*). The page halves are define a pocket associated with each locking finger and each locking finger is disposed in one of the pockets to protect the locking finger (*figures 4 and 5*). The page halves are connected together with adhesive (*page 1, lines 83-96*). The container is further deemed to comprise a literature cars disposed between the page halves when the page contains a phonographic disk, since the examiner takes official notice that phonographic disk comprise labels with information thereon. Each page half includes a rear surface and the rear surface of each page half including planar portions that abut the literature card (*figure 2*). At least one of the page halves is substantially transparent, since it has an opening for viewing the title of the disk record (*page 2,*

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*lines 8-10*). The front and rear covers pivot with respect to the outer spine independent of the rigid page (*figure 3*).

The limitation “weld” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

#### ***ANSWERS TO APPLICANT’S ARGUMENTS***

6. Applicant’s arguments in the Appeal Brief filed on January 19, 2010 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Thursday from 11:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/

Primary Examiner, Art Unit 1783

4/13/2010